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ORWIG, KEVIN S				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/528,698

**Applicant(s)**

FERRARI ET AL.

**Examiner**

Kevin S. Orwig

**Art Unit**

1611

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 65-69, 71-74, 76 and 78-147 is/are pending in the application.
- 4a) Of the above claim(s) 137-146 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 65-69, 71-74, 76, 78-136 and 147 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 3/10/09
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

The amendments filed Mar. 10, 2009 were entered.

#### ***Response to Amendments/Arguments***

Applicants' amendments and arguments filed Mar. 10, 2009 are acknowledged and have been fully considered. Applicants' arguments are moot in light of the new grounds of rejection set forth below.

#### ***Status of the Claims***

Claims 1-64, 70, 75, and 77 are cancelled; claims 65-69, 71, 73-74, 76, 78-85, 87-88, 90-92, 95-98, 100, 102-113, 115-121, 130-132, 134, 137-138, and 142-146 are amended; claim 147 has been added. Claims 65-69, 71-74, 76, and 78-147 are now pending. Non-elected claims 137-146 are withdrawn from consideration. Claims 65-69, 71-74, 76, 78-136, and 147 are the subject of this Office Action.

#### ***Election/Restrictions***

The finality of the Restriction Requirement is maintained. The claims are properly rejected as obvious over the prior art references discussed below. Thus, the claims do not share a special technical feature that defines a contribution over the art and are subject to restriction.

Applicants' remarks regarding previously withdrawn claim 89 are noted. Upon further consideration, the examiner agrees that claim 89 encompasses an embodiment readable upon the elected species and was therefore improperly withdrawn. Claim 89

is hereby included in the claims examined in this Office Action. Thus, this Office Action is made non-final since this claim was not previously rejected.

***Information Disclosure Statement***

Regarding the prior filed Information Disclosure Statements and the IDS filed Mar. 10, 2009, the references have been considered to the extent that they have been provided in English. References lined-through on the information disclosure statement(s) were not considered because they were not provided or were not provided in English. The examiner cannot consider documents that were not provided or were not provided in English. If applicants believe that the documents lined through were provided or were provided in English, applicants are invited to direct the examiner to such documents.

***Withdrawn Objections/Rejections***

All objections and rejections set forth in the previous Office Action mailed Dec. 10, 2008 are withdrawn in view of applicants' amendments.

***Claim Rejections - 35 USC § 112 (1<sup>st</sup> Paragraph)***

**Claims 65-69, 71-74, 76, 78-136, and 147 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.** The claim(s) contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the

time the application was filed, had possession of the claimed invention. The response filed Mar. 10, 2009 has introduced NEW MATTER into the claims. The amended claims now recite that the lip makeup composition is required to have a resistive index of greater than or equal to 80%. Applicants point vaguely to "at least pages 2-6 in the specification or in the corresponding original claims" (see p. 24 of the response). However, written description support is lacking for the requirement that the lip makeup composition definitively HAVE a resistive index of greater than 80% since pages 2-6 and the corresponding original claims only support that the lip makeup composition is *capable of forming* a deposit that has a resistive index of greater than or equal to 80%. Nowhere in the portion of the specification pointed to by applicants is proper written description support provided, which is commensurate in scope with the claims, of a lip makeup composition that definitively HAS a resistive index of greater than 80%.

If proper written description support exists in the specification and/or original claims, applicants are encouraged to be more specific in future responses in order to facilitate compact prosecution. Instant claim(s) 65-69, 71-74, 76, and 78-147 now recite limitations, which were not clearly disclosed in the specification as filed, and now change the scope of the instant disclosure as filed. Such limitations recited in amended claims 65-69, 71-74, 76, and 78-147, which did not appear in the specification, as filed, introduce new concepts and violate the description requirement of the first paragraph of 35 U.S.C 112. Applicant is required to provide sufficient written support for the limitations recited in present claims 65-69, 71-74, 76, and 78-147 in the specification or

claims, as-filed, or remove these limitations from the claims in response to this Office Action.

Additionally, the response did not point out where support for amended claims 79-82, 84, 85, 87, 88, 90, and 91 could be found in the originally filed disclosure. Support for the amendments to these claims was not found throughout the specification or original claims. When filing an amendment an applicant should show support in the original disclosure for new or amended claims. See MPEP 714.02 and 2163.06 ("Applicant should therefore specifically point out the support for any amendments made to the disclosure."). Instant claim(s) 79-82, 84, 85, 87, 88, 90, and 91 now recite limitations, which were not clearly disclosed in the specification as filed, and now change the scope of the instant disclosure as filed. Such limitations recited in amended claims 79-82, 84, 85, 87, 88, 90, and 91, which did not appear in the specification, as filed, introduce new concepts and violate the description requirement of the first paragraph of 35 U.S.C 112. Applicant is required to provide sufficient written support for the limitations recited in present claims 79-82, 84, 85, 87, 88, 90, and 91 in the specification or claims, as-filed, or remove these limitations from the claims in response to this Office Action.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**Claims 65-69, 71-74, 76, 78-136, and 147 are rejected under 35 U.S.C. 103(a) as being unpatentable over ANTON (U.S. Patent No. 6,153,206; Issued Nov. 28, 2000; Reference # 35 on IDS dated Sep. 21, 2006) in view of FRECHET (U.S. 6,663,855; Filed Oct. 3, 2001; Reference # 65 on IDS dated Mar. 10, 2009) and MELCHIORI (U.S. 2002/0151638; Filed Mar. 25, 2002).**

1. Anton discloses cosmetic compositions comprising an oil component and a synthetic ethylenic block polymer (abstract; col. 2, lines 9-23; claim 1). Anton teaches that the polymer of the invention comprises portions having a low glass transition temperature ( $T_g$ ) and portions having a high  $T_g$  and teaches that one block is preferably constructed from isobornyl methacrylate (elected species) (col. 4, lines 5-27; Example 1). Anton teaches that the oil component is a volatile or nonvolatile oil (i.e. an organic liquid medium) (col. 6, lines 8-10 and 17-19). Anton teaches that the compositions are useful as transfer resistant lipsticks (col. 1, lines 65-67; Example 1). Anton further

teaches that the polymer of the invention may be a copolymer, a terpolymer (i.e. a polymer of three different monomers), or have any number of different units in addition to the first and second repeat units (i.e. blocks) (col. 2, lines 58-62; col. 4, lines 28-60). In particular, Anton teaches block terpolymers and teaches that the repeating units are monomer units which are present more than one time in the polymer chain and can be present in either repetitive sequence or in random sequence with other monomer units (col. 3, lines 21-24).

2. Frechet discloses cosmetic compositions comprising linear block copolymers formed by a core polymer surrounded by two or more flanking polymers (abstract; col. 3, lines 52-57). Frechet teaches that the flanking polymers may be different from each other in terms of their composition and/or molecular weight (col. 6, lines 35-37) and teaches that the core and flanking polymers may comprise different monomers or may have one or more monomers in common (col. 6, lines 54-56). Frechet teaches that the  $T_g$  value of the core polymer is  $-200$ - $150$  °C (most preferably from  $-75$ - $50$  °C) and is different from that of the flanking polymers, which typically have  $T_g$  values of  $0$ - $300$  °C (more preferably from  $30$ - $150$  °C (col. 4, lines 21-36). In line with the teachings of Anton, Frechet teaches the importance of the polymers having both hard and soft blocks (col. 4, lines 33-36). Frechet teaches that one or more blocks can be random copolymer blocks and the overall polymer may have a variety of architectures such as A-R-B-A or A-R-B-R-A, where R is a random block of monomers A and B or of monomers B and C or more monomers. Moreover, the random block can vary in composition or size with respect to the overall block copolymer (col. 10, lines 25-44).



3. Neither Anton nor Frechet discloses the polydispersity of their polymers. It is the examiner's position that it would have been obvious and fully within the purview of one having ordinary skill in the art to control the optimum molecular weight, polydispersity, polymer composition and architectures of the resultant block copolymer product by varying experimental parameters such as source, amount, and solvation of catalyst/initiators/control agents, polymerization temperature and time, etc., as taught by the references referred to by Anton (col. 5, line 64 to col. 6, line 6). Nonetheless, one would have looked to the art to ascertain an acceptable polydispersity value for the polymers. Melchior discloses copolymer compositions with the object of providing coating compositions with high resistance to solvents, water, and environmental influences with very good optical properties (gloss) and mechanical properties (hardness, flexibility), which can be applied in a wide range of fields (paragraphs [0013], and [0037]). Melchior teaches that polydispersity values of 2.9-3.5 are acceptable to achieve the objects of the invention Table 1. Thus, the combined teachings of Anton, Frechet, and Melchior render claims 75 and 76 obvious.

4. Frechet teaches that it is known in the art that the selection of macromers with different physical and chemical properties such as solubility and  $T_g$  value is a means to select the desired overall polymer properties (col. 1, lines 25-33). Frechet further teaches that block copolymers are advantageous over graft copolymers since the polymer architecture can be controlled more readily, and that this is particularly important when designing polymers with segments of distinct physical and chemical properties for particular applications (col. 1, lines 48-54). Frechet teaches that the

polymers can be readily tailored to a particular application by changing the chemical composition (e.g. the types of monomers and their proportions) to optimize the physical properties such as solubility and  $T_g$  value (col. 2, lines 44-49; col. 6, lines 13-27).

5. In light of these teachings, it would have been *prima facie* obvious to one of ordinary skill in the art at the time of the invention to prepare a polymer arranged with a first block and a second block connected by an intermediate block comprising both types of monomers, to provide a suitable polymer compound. One would have been motivated to do so since the teaching of Anton suggests such an arrangement, and since one of ordinary skill in the art would recognize that including a block comprising monomers from the "hard" and "soft" portions provides an additional means (besides the weight % of each block) to manipulate the overall properties of the polymer, as taught by Frechet. Further, it is well within the skill of ordinary artisan to select the appropriate properties of a copolymer for a given formulation. Therefore if an artisan wanted to produce a polymer with both high flexibility and shine qualities, one would have been motivated to arrange the "hard" and "soft" polymer blocks such that they were connected by an intermediate block as suggested by Anton and taught by Frechet. It would have been *prima facie* obvious to one of ordinary skill in the art at the time of the invention to formulate a polymer with a core and flanking blocks having different compositions and  $T_g$  values as taught by Frechet, to provide a transfer resistant lip makeup composition using isobornyl methacrylate as a preferred monomer as taught by Anton and to formulate the polymer with a polydispersity of 2.9-3.5 as taught by Melchior. One would have had a high expectation of success given that each of the

references are concerned with similar problems in the art, namely providing compositions with desirable cosmetic properties. The skilled artisan, in possession of Anton, Frechet, and Melchioris could have arrived at the instantly claimed invention by no more than routine experimentation. Furthermore, the MPEP states that the selection of known materials based on their suitability for their intended uses is *prima facie* obvious. "Reading a list and selecting a known compound to meet known requirements is no more ingenious than selecting the last piece to put in the last opening in a jig-saw puzzle." 325 U.S. at 335, 65 USPQ at 301. See MPEP § 2144.07. In the instant case, applicants are claiming a combination of known monomers, all of which are taught by Anton and Frechet, for the same purpose as that which has been taught in the art.

6. Anton does not measure the "resistive index" of the compositions. It is noted that "resistive index" is a measurement of the transfer resistance of the composition as evidenced by paragraphs [0014]-[0026] of the instant specification, wherein a sample of the composition (on a support) is pressed onto white paper and moved through deposits of oil and water and the deposit remaining on the support is measured after this process. While Anton does not measure the transfer resistance of the compositions in such a specialized assay, it is an object of Anton's lipstick compositions to provide high transfer resistance (col. 1, line 65 to col. 2, line 3; Example 1). Thus, it is reasonable that the transfer resistant lipstick compositions taught by Anton (e.g. Example 1) would have this property. Furthermore, since the object of Anton's invention is to provide high transfer resistance, it would be obvious to an artisan to formulate the compositions with maximal transfer resistance, or "resistive index".

7. The U.S. Patent Office is not equipped with analytical instruments to test prior art compositions for the infinite number of ways that a subsequent applicant may present previously unmeasured characteristics. When, as here, the prior art appears to contain the exact same ingredients and applicant's own disclosure supports the suitability of the prior art composition as the inventive composition component, the burden is properly shifted to applicant to show otherwise.

8. Regarding the limitations "styrene-free" in claims 65 and 114, and the limitation "non-elastomeric" in claims 66 and 119, Anton teaches styrene-free transfer resistant lipsticks (Example 1) and teaches the use of the same monomer components of the block polymers as those instantly claimed. Thus, the compositions of Anton are both styrene-free and non-elastomeric.

9. Regarding claim 69, Anton does not disclose the solubility of the block polymers, but teaches the use of the same monomer components of the block polymers as those instantly claimed (see below). Therefore, it is reasonable that the polymers taught by Anton will not be soluble at an active material content of at least 1% by weight in water, and thus meet the limitations of claim 69.

10. Anton teaches that the molecular weight average of the polymer is from 5,000 to 300,000, but is preferably from 5,000 to 50,000 (col. 5, lines 23-28). Anton exemplifies a composition comprising a polymer having a molecular weight of 27,100 (Example 1), reading on instant claims 115-118.

11. Anton teaches that the preferred compositions comprise from 3-30% of the copolymer (col. 11, line 10), and embodies the copolymer in the range of 19-20% by weight of the composition (Example 1), reading on claims 120 and 121.
12. As discussed above, Anton teaches that the oil component is a volatile or nonvolatile oil and exemplifies 6% isododecane in the transfer resistant lipstick composition (Example 1), reading on claims 122-124.
13. Anton also teaches that the nonvolatile oil may be a hydrocarbon-based oil (col. 7, lines 44-45) or nonvolatile silicone oil (col. 7, line 54-67). Anton exemplifies 8% of the nonvolatile oil fluoro octyldodecyl meadowfoamate (Example 1), reading on claims 126-128.
14. Anton teaches that the preferred compositions of the invention comprise 1-30% of a wax (col. 9, lines 41-49; col. 11, lines 8-21), and exemplifies a composition comprising 7% synthetic wax (Example 1), reading on claims 130-132.
15. Anton also teaches that the compositions include dyestuffs (col. 9, lines 17-20; see Example 1, wherein D&C and FD&C lakes are dyestuffs), reading on claim 133.
16. Anton teaches that it is desirable to add other ingredients such as preservatives, antioxidants, vitamins, eumulsifiers (i.e. surfactants) and the like (col. 11, lines 5-7). Furthermore, Anton teaches that the compositions most preferably contain additional shine enhancers, which are polymers with high refractive index (col. 11, lines 22-24) and exemplifies compositions containing fragrances (Example 1), reading on claim 134.
17. Anton teaches the composition in the form of an anhydrous stick (col. 2, lines 24-36 and 40-42; claim 19), reading on claims 135 and 136.

18. Anton teaches that the first repeat unit has a  $T_g$  of about  $-10$ - $75^{\circ}\text{C}$  and the second repeat unit has a  $T_g$  of about  $76$ - $120^{\circ}\text{C}$  (abstract; col. 4, line 62 to col. 5, line 1). Specifically, Anton embodies a polymer comprising blocks of isobornyl methacrylate ( $T_g = 110^{\circ}\text{C}$ ) and isobutyl methacrylate ( $T_g = 53^{\circ}\text{C}$ ) (Example 1) and teaches that a variety of other monomers are useful in the polymers, for instance n-butylmethacrylate ( $T_g = 20^{\circ}\text{C}$ ), hexyl methacrylate ( $T_g = -5^{\circ}\text{C}$ ) (col. 3, line 56 to col. 4, line 38; col. 5, lines 33-54, see the second table in col. 5). Thus, it would be obvious to an ordinary artisan to use any combination of these monomers.
19. Regarding claim 73, it is reasonable that a block comprising monomers from each of a "hard" and "soft" block will have a  $T_g$  between these two extremes, as would be recognized by the ordinary artisan. For example, Anton teaches that the overall  $T_g$  of the polymer lies between that of the isolated "hard" and "soft" segments (abstract; col. 2, lines 13-23). Thus, given the teachings of Anton, Frechet, and Melchioris, claim 73 is rendered obvious.
20. Regarding claim 74, Anton does not disclose the compatibility of the various polymer blocks, and does not disclose the solubility of the blocks in the major organic liquid medium of the composition, which is how mutual incompatibility is defined in the instant specification (paragraph [0042]). Nonetheless, since Anton discloses substantially the same composition to that instantly claimed, including the same types of monomers, and blocks thereof, it is reasonable that these blocks are mutually incompatible as defined in the instant specification. Thus, claim 74 is rendered obvious by Anton, Frechet, and Melchioris.

21. Anton teaches that relative to the polymer, the portions of the first and second repeat units can vary from 2-99% by weight of the first repeat unit to 1-98% by weight of the second repeat unit and vice versa (col. 5, lines 3-32). Thus, it would be obvious to an ordinary artisan to use any percentage within this range for each of the blocks. As discussed above, both Anton and Galleguillos teach that manipulating the percentages of the blocks alters the properties of the final polymer. Thus, the skilled artisan would be motivated to do so to optimize the properties of the polymer for a particular formulation. Therefore, the combination of Anton, Frechet, and Melchior renders claims 79-82, 84, 85, 87, 88, 90, and 91 obvious.

22. Anton teaches a variety of monomers useful for the various polymer blocks of the polymer (col. 3, line 56 to col. 4, line 27; second table in col. 5). In particular, Anton teaches 2-ethylhexylmethacrylate ( $T_g = -10^\circ\text{C}$ ), which is encompassed by the formulas of methacrylates (i.e. alkyl acrylates) recited in instant claims 100 and 101. As stated above, it would be *prima facie* obvious to an ordinary artisan to use any combination of these monomers as defined by the teachings of Anton, rendering claims 100 and 101 obvious. Furthermore, as discussed above, Anton teaches block terpolymers and teaches that the repeating units are monomer units which are present more than one time in the polymer chain and can be present in either repetitive sequence or in random sequence with other monomer units (col. 3, lines 21-24). Furthermore, Anton describes polymer architectures comprising homopolymeric blocks (col. 4, lines 28-60), as does Frechet. Thus, it would have been obvious to an ordinary artisan to produce a polymer

having homopolymeric blocks of any of the monomers taught by Anton, such as 2-ethylhexylmethacrylate, rendering claims 102 and 103 obvious.

23. As stated above, Anton teaches n-butylmethacrylate ( $T_g = 20^\circ\text{C}$ ) in addition to other monomers useful in the blocks of the invention in addition to isobornyl methacrylate (col. 3, line 56 to col. 4, line 38; col. 5, lines 33-54, see the second table in col. 5), thus claim 104 is obvious over Anton, Frechet, and Melchioris.

24. Anton teaches block polymers of various configurations containing blocks of differing  $T_g$  values. Anton teaches (and exemplifies) polymers wherein one block comprises isobornyl methacrylate, which has a high  $T_g$  (Example 1). The other block may comprise monomers that, if polymerized, have much lower  $T_g$  values. These other monomers include 2-ethylhexylmethacrylate ( $T_g = -10^\circ\text{C}$ ). As discussed above, per the teachings of Frechet, it would have been obvious to produce a block polymer having a block A comprising isobornyl methacrylate, a block B comprising 2-ethylhexylmethacrylate, and an intermediate block comprising each monomer. This type of polymer encompasses that claimed in instant claims 105 and 106.

25. Regarding claims 107 and 108, it is noted that Applicants have elected the species acrylic acid and have stated that this species reads on claim 108. Since acrylic acid does not contain a silicon atom, it is therefore presumed that acrylic acid is a hydrophilic monomer. Anton teaches a variety of monomers useful for the various polymer blocks of the polymer (col. 3, line 56 to col. 4, line 27; second table in col. 5). As stated above, it would be *prima facie* obvious to an ordinary artisan to use any combination of these monomers as defined by the teachings of Anton. Furthermore, as



discussed above, Anton teaches block terpolymers and teaches that the repeating units are monomer units which are present more than one time in the polymer chain and can be present in either repetitive sequence or in random sequence *with other monomer units* (col. 3, lines 21-24). Furthermore, Anton describes polymer architectures comprising at least three different monomers (col. 4, lines 28-60) and teaches that the final polymer may contain, in addition to the first and second repeat units, other monomeric units such as ethylenically unsaturated monomer units and silicon repeat units. Thus, it would have been prima facie obvious to an ordinary artisan at the time of the invention to include such an additional monomer (in addition to isobornyl methacrylate and, for example 2-ethylhexylmethacrylate), in the polymer as taught by Anton. While Anton teaches methacrylic acid and esters thereof, acrylic acid itself is not disclosed.

26. However Frechet discloses that both methacrylic acid and acrylic acid are highly preferred monomers in the block polymers of the invention (col. 7, lines 6-9; col. 8, lines 8-10 and 58; col. 9, line 15). One of ordinary skill in the art would be motivated to substitute acrylic acid for methacrylic acid due to the similarities of these compounds and since Frechet establishes them as functional equivalents. Thus, the artisan would have a high expectation of success by substituting one functional equivalent for another, rendering claims 107-110 and 112 obvious.

27. While Anton does not disclose the weight % of the additional monomer relative to the first and/or second blocks, it is the examiner's position that it would be well within the skill of the ordinary artisan to adjust the amount of the additional monomer based on

the teachings of Anton (see upper table in col. 5). One would be motivated to adjust the amount of the additional monomer for the reasoning presented above regarding the intermediate block, which is to achieve the optimal and desired properties of the polymer through manipulation of the types and configurations of the monomers therein as taught by both Anton and Frechet. Thus, claim 111 is obvious over these references.

28. Anton teaches block terpolymers and teaches that the repeating units are monomer units which are present more than one time in the polymer chain and can be present in either repetitive sequence or in random sequence with other monomer units (col. 3, lines 21-24). Furthermore, Anton describes polymer architectures comprising homopolymeric blocks (col. 4, lines 28-60), as does Frechet (col. 4, structures 1 and 2). Thus, it would have been obvious to an ordinary artisan to produce a polymer having homopolymeric blocks of any of the monomers taught by Anton, as well as the functional equivalents taught by Frechet, such as acrylic acid, rendering claims 113 obvious.

29. Anton teaches that the preferred composition comprises a volatile oil in the range of 10-40% (col. 11, lines 8-21). Thus, it would be obvious to use a volatile oil in this range as taught by Anton, rendering claim 125 obvious. Anton teaches that the preferred composition comprises a nonvolatile oil in the range of 10-30% (col. 11, lines 8-21). Thus, it would be obvious to use a nonvolatile oil in this range as taught by Anton, rendering claim 129 obvious.

30. Regarding new claim 147, Frechet teaches that isobutyl acrylate is a preferred monomer component in addition to acrylic acid (col. 8, lines 10 and 65-66; col. 9, lines 38-39). In combination, Anton, Frechet, and Melchior render claim 147 obvious.

A reference is good not only for what it teaches by direct anticipation but also for what one of ordinary skill in the art might reasonably infer from the teachings. (*In re Opprecht* 12 USPQ 2d 1235, 1236 (Fed Cir. 1989); *In re Bode* 193 USPQ 12 (CCPA) 1976). In light of the forgoing discussion, the examiner concludes that the subject matter defined by the instant claims would have been obvious within the meaning of 35 USC 103(a). From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, in the absence of evidence to the contrary, the invention as a whole was *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 65-69, 71-74, 76, 78-136, and 147 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-56 of copending Application No. 10/529,264. Although the conflicting claims are not identical, they are not patentably distinct from each other because the scope of the '264 claims renders obvious that of the instant claims. The difference between the two claim sets is that the '264 claims recite that the composition is capable of forming a deposit that has a transfer of less than or equal to 35%, while the instant claims recite a composition that can form a deposit that has a resistive index of greater than or equal to 80%. Both of these limitations are drawn to the transfer resistance of the composition, and indicate that each is to resist transfer. Since each application recites the same monomer components and architecture, in the absence of evidence to the contrary, it is reasonable that the compositions claimed in the '264 application would meet the instant limitation. It is noted that '264 claim 23 recites the elected species of isobornyl (meth)acrylate and claim 36 recites acrylic acid, the elected species for the additional monomer. Thus, the scope of the two claim sets is substantially identical, and the entire scope of the instant claims is rendered obvious over the '264 claims.

U.S. Patent Application No. 10/528,835

Claims 65-69, 71-74, 76, 78-136, and 147 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 85-155 of copending Application No. 10/528,835. Although the conflicting claims are not identical, they are not patentably distinct from each other because the scope of the '835 claims renders obvious that of the instant claims. The difference

between the two claim sets is that the '835 claims recite a gelling agent and do not include a limitation regarding resistive index. However, since resistive index is an inherent property of a given polymer and since each application recites the same monomer components and polymer architecture, in the absence of evidence to the contrary, it is reasonable that the compositions claimed in the '835 application would meet the instant resistive index limitations. Further, it is noted that instant claim 130 recites the addition of gums, which are suitable gelling agents according to the '835 claims. Additionally, '835 claim 97 recites the elected species of isobornyl (meth)acrylate and claim 138 recites acrylic acid, the elected species for the additional monomer. Thus, the scope of the two claim sets is substantially identical, and the entire scope of the instant claims is rendered obvious over the '835 claims.

Claims 65-69, 71-74, 76, 78-136, and 147 are directed to an invention not patentably distinct from claims 85-155 of commonly assigned 10/528,835. Specifically, see above.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned 10/528,835, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were

commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

U.S. Patent Application No. 10/529,266

Claims 65-69, 71-74, 76, 78-136, and 147 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 77-163 of copending Application No. 10/529,266. Although the conflicting claims are not identical, they are not patentably distinct from each other because the scope of the '266 claims anticipates or renders obvious that of the instant claims. The difference between the two claim sets is that the '266 claims recite that the composition has a mean gloss of greater than or equal to 30 out of 100 and that the transfer index is less than or equal to 40 out of 100. The latter limitation is drawn to the transfer resistance of the composition, and indicates that the composition is to resist transfer, as is the case with the instant claims. Regarding the limitations of a mean gloss value, the gloss of a lipstick formulation would be optimized by the skilled artisan. As taught by Anton, the "hard" portions of the polymers taught are responsible for shine of the polymer. Thus, it would be obvious to an ordinary artisan to optimize the gloss of the lipstick formulation. Since each application recites the same monomer components and architecture, in the absence of evidence to the contrary, it is reasonable that the

compositions claimed in the instant application would meet the '266 limitation. It is noted that '266 claim 117 recites the elected species of isobornyl (meth)acrylate and claim 154 recites acrylic acid, the elected species for the additional monomer. Thus, the scope of the two claim sets is substantially identical, and the entire scope of the instant claims is rendered obvious over the '266 claims.

Claims 65-69, 71-74, 76, 78-136, and 147 are directed to an invention not patentably distinct from claims 77-163 of commonly assigned 10/529,266. Specifically, see above.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned 10/529,266, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

U.S. Patent Application No. 10/529,218

Claims 65-69, 71-74, 76, 78-136, and 147 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 80-165 of copending Application No. 10/529,218. Although the conflicting claims are not identical, they are not patentably distinct from each other because the scope of the '218 claims anticipates or renders obvious that of the instant claims. The difference between the two claim sets is that the '218 claims recite that the composition has a mean gloss of greater than or equal to 30 out of 100. Regarding the limitations of a mean gloss value, the gloss of a lipstick formulation would be optimized by the skilled artisan. As taught by Anton, the "hard" portions of the polymers taught are responsible for shine of the polymer. Thus, it would be obvious to an ordinary artisan to optimize the gloss of the lipstick formulation. Since each application recites the same monomer components and architecture, in the absence of evidence to the contrary, it is reasonable that the compositions claimed in the instant application would meet the '218 limitation. It is noted that '218 claim 97 recites the elected species of isobornyl (meth)acrylate and claim 135 recites acrylic acid, the elected species for the additional monomer. Thus, the scope of the two claim sets is substantially identical, and the entire scope of the instant claims is rendered obvious over the '218 claims.

Claims 65-69, 71-74, 76, 78-136, and 147 are directed to an invention not patentably distinct from claims 80-165 of commonly assigned 10/529,218. Specifically, see above.



The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned 10/529,218, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

### ***Conclusion***

No claims are currently allowable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin S. Orwig whose telephone number is (571)270-5869. The examiner can normally be reached Monday-Friday 7AM-4PM4:00 pm (with alternate Fridays off). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharmila Landau can be reached Monday-Friday 7AM-4PM pm at (571)272-0614. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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KSO

/David J Blanchard/  
Primary Examiner, Art Unit 1643